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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* INGO BOECKMANN,  
HOLGER EBERT and MATTHIAS HEIMERMANN

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Appeal 2008-0306  
Application 09/807,638  
Technology Center 2600

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Decided: June 18, 2008

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Before MAHSHID D. SAADAT, ROBERT E. NAPPI, and  
JOHN A. JEFFERY, *Administrative Patent Judges*.

SAADAT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 11-29, which are all of the claims pending in this application, as claims 1-10 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

Appellants invented a method and system for outputting information and/or status messages of at least one electrical device, using speech. According to Appellants, by using different intonations, increased volume of the voice, or choosing between a man's voice and a woman's voice, attention of the user is obtained for instructions that require immediate action (Spec. 3). An understanding of the invention can be derived from a reading of independent claim 11 and dependent claims 20 and 24, which are reproduced as follows:

11. A method for outputting at least one of information and status messages of at least one electrical device using speech, comprising the steps of:

- storing the at least one of information and status messages relating to a voice output in a speech memory;
- selectively reading the at least one of information and status messages by a processing device; and
- outputting the at least one of information and status messages on an output device using an intonation in accordance with a relevance.

20. The method according to claim 11, wherein the storing step includes the substep of storing in the speech memory a plurality of alternatives of the at least one of information and status messages, and wherein the outputting step includes the substeps of:

- successively outputting the alternatives of the at least one of information and status messages in response to a failure to interact with the at least one of information and status messages until an interaction occurs; and
- changing a dialog-communication level in response to a failure to interact with a last of the successive alternatives of the at least one of information and status messages.

24. The method according to claim 20, wherein a sequence of the output of the successive alternatives is based on a permutation by a random-number generator.

The Examiner relies on the following prior art references:

Tsunoda	US 4,359,713	Nov. 16, 1982
Mandel	US 4,400,787	Aug. 23, 1983
Nara	US 5,007,095	Apr. 9, 1991
Gulau	US 5,584,052	Dec. 10, 1996
Chen	US 5,864,805	Jan. 26, 1999
Marx	US 6,173,266 B1	Jan. 9, 2001

Claims 11-18, 21-23, 28, and 29 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Tsunoda.

Claim 19 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsunoda and Gulau.

Claims 20 and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsunoda and Marx.

Claim 24 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsunoda and Marx in view of Nara.

Claim 25 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsunoda and Marx in view of Mandel.

Claim 27 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsunoda and Marx in view of Chen.

We make reference to the Briefs<sup>1</sup> and Answer, as well as the Final Rejection (Final), for the respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but did not make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

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<sup>1</sup> We refer to the most recent Appeal Brief, filed on August 15, 2006 and the Reply Brief, filed on June 18, 2007.

## ISSUES

1. Under 35 U.S.C. § 102(b), does Tsunoda have a disclosure which anticipates the invention set forth in claims 11-18, 21-23, 28, and 29?
2. Under 35 U.S.C. § 103(a), with respect to appealed claims 19, 20, and 24-27, would one of ordinary skill in the art at the time of the invention have found the claimed invention obvious over the teachings of Tsunoda in various combinations with Gulau, Marx, Nara, Mandel, and Chen?

## PRINCIPLES OF LAW

### 1. ANTICIPATION

In rejecting claims under 35 U.S.C. § 102, a single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. *Perricone v. Medicis Pharmaceutical Corp.*, 432 F.3d 1368, 1375-76 (Fed. Cir. 2005), citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992). Anticipation of a patent claim requires a finding that the claim at issue “reads on” a prior art reference. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed Cir. 1999) (“In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.”) (internal citations omitted).

### 2. OBVIOUSNESS

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of

obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). “[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Furthermore,

‘there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ . . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.’ *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007)(quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

## ANALYSIS

### *35 U.S.C. § 102(b) rejection of claims 11-18, 21-23, 28, and 29 over Tsunoda*

With respect to the 35 U.S.C. § 102(b) rejection, the Examiner indicates (Final 4) how the various limitations are read on the disclosure of Tsunoda. The Examiner characterizes the claimed steps of storing and reading on the functions of elements 10 and 11 shown in Figure 1 of Tsunoda as well as the accompanying description at column 3, lines 24-35. In particular, the Examiner directs attention to the description of the volume controller in column 5, lines 15-41 for outputting messages “using an intonation in accordance with a relevance” (*id.*).

Appellants’ arguments in response assert that the Examiner has not shown how each of the claimed features is present in the disclosure of

Tsunoda so as to establish a prima facie case of anticipation. Appellants' arguments focus on the contention that, in contrast to the requirements of appealed claim 11, Tsunoda does not disclose outputting information or speech using an intonation in accordance with relevance (App. Br. 3; Reply Br. 3). According to Appellants (App. Br. 4), while Tsunoda discusses variations in volume with respect to tone, pitch, and loudness to distinguish warning information importance, there is no disclosure of "outputting the at least one of information and status messages on an output device using an intonation in accordance with a relevance," as claimed. Appellants provide the same arguments with respect to independent claim 21 (App. Br. 7-8).

Upon a review of the disclosure of Tsunoda, however, we find sufficient evidence to support the Examiner's position. As disclosed at column 5, lines 29-41 of Tsunoda, louder voice message or warning is used to provide information to the driver when the engine is quiet in the case of the washer liquid level being low or when the message is important or urgent in the case of low fuel level. Therefore, the message loudness is changed according to the type or importance of the message. Tsunoda further provides other types of changes made to the message voice such as tone, pitch, or speaking voice such as male or female voices in addition to loudness (col. 7, ll. 49-68).

We disagree with Appellants (Reply Br. 2) that increasing the volume of the message is different from using intonation, as recited in claim 11. Although intonation may include other aspects of the outputted signal, the broadest reasonable interpretation of "intonation" does not preclude changing loudness with respect to speech. Additionally, Tsunoda discloses that the louder voice level is used when the message is urgent or more

important (col. 5, l. 39), which indicates using intonation according to the message content and importance or according to its relevance to the situation.

Regarding claim 13, Appellants argue that Tsunoda's variations in volume is different from the claimed using "command intonation" (App. Br. 5). We disagree. Using a higher volume when the message is urgent and immediate action is needed in Tsunoda does indeed give the message a command intonation.

Regarding claim 16, Appellants argue that using different speaking voices in Tsunoda is for distinguishing between voice information that is output simultaneously or in quick succession (App. Br. 5). Appellants make similar arguments regarding claim 23 (App. Br. 8-9). As pointed out by the Examiner (Ans. 8), Tsunoda uses different speaking voices for two kinds of voice information that are required to be indicated to the driver at the same time as well as for different warnings based on their order of priority according to the importance of the warning information (col. 7, ll. 49-53). As such, the speaking voice chosen for each warning may change if that warning requires immediate action.

With respect to claims 17 and 18, Appellants' arguments (App. Br. 6-7) are similar to those made regarding claim 13. Based on the same reasons outlined above with respect to claim 13, we also find that Tsunoda teaches the limitations of increased intonation and connotation of claims 17 and 18.

In view of the above discussion, since all of the claimed limitations are present in the disclosure of Tsunoda, the Examiner's 35 U.S.C. § 102(b) rejection of independent claims 11-18, 21-23, 28, and 29 is sustained.



*35 U.S.C. § 103 rejection of claim 19 over Tsunoda and Gulau*

With respect to claim 19, Appellants' only argument is that Gulau does not disclose the features recited in claim 11 which are not disclosed in Tsunoda (App. Br. 9; Reply Br. 5). However, based on our above discussion of Tsunoda with respect to claim 11, we find that the combination of Tsunoda and Gulau would have suggested to one of ordinary skill in the art the subject matter recited in claim 19.

*35 U.S.C. § 103 rejection of claims 20 and 26 over Tsunoda and Marx*

Appellants argue that the switchover to the fallback method described in Marx does not depend on a failure to interact with a last one of successive alternatives, but depends on reaching a threshold retry number even if further prompts are available (App. B. 10; Reply Br. 6). The Examiner responds by pointing to the claim requirement for changing the dialog-communication level in response "to a failure to interact with a last of the successive alternatives," and not "to the last of the plurality of alternatives stored in a speech memory," argued by Appellants (Ans. 11). We agree with the Examiner since the threshold number of Marx defines a set of successive alternatives stepped through for eliciting a response (col. 13, ll. 59-67). As such, although other alternative prompts may be stored in the memory, the threshold number dictates the number of prompts in a set of successive alternatives related to a specific failure and possible responses. Therefore, the combination of Tsunoda and Marx would have suggested to one of ordinary skill in the art at the time of the invention the subject matter recited in claims 20 and 26.

*35 U.S.C. § 103 rejection of claim 24 over Tsunoda, Marx, and Nara*

Appellants argue that Nara is unrelated to randomizing a sequence of an output of stored alternatives of information or status messages and, therefore, its combination with Tsunoda and Marx does not teach or suggest the recited features of claim 24 (App. Br. 11-12; Reply Br. 7-8). However, we agree with the Examiner (Ans. 12) that Nara discloses changing a specific speech synthesis output based on a random number generator. Although Nara uses a random number generator in speech synthesis (col. 9, ll. 3-19), the resulting speech is constructed randomly in the form of alternatives messages. Therefore, following the principles articulated in *KSR* and the broadest reasonable interpretation of the claims, applying random numbers to a series of synthesized messages, such that the sequence of the output of the alternatives varies according to the generated speech, generates nothing but predictable results. Based on our analysis of Nara and the discussions made above regarding claims 11 and 20, the combination of Tsunoda and Marx with Nara would have suggested to one of ordinary skill in the art the subject matter recited in claim 24.

*35 U.S.C. § 103 rejection of claims 25 and 27 over Tsunoda and Marx in view of Mandel and Chen*

Appellants mainly rely on the same arguments made with respect to claims 11 and 20 and assert that neither Mandel nor Chen disclose the features that are absent in Tsunoda and Marx (App. Br. 12-13; Reply Br. 8-9). For the same reasons discussed above regarding claims 11 and 20, we agree with the Examiner that the combination of Tsunoda and Marx with

Mandel or Chen would have suggested to one of ordinary skill in the art the subject matter recited in claims 25 and 27.

### CONCLUSION

On the record before us, Appellants have failed to show that the Examiner erred in rejecting claims 11-29. In view of our analysis above, we sustain the 35 U.S.C. § 102 rejection of claims 11-18, 21-23, 28, and 29 and the 35 U.S.C. § 103 rejections of claims 19, 20, and 24-27.

### DECISION

The decision of the Examiner rejecting the claims is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2006).

### AFFIRMED

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